

REMARKS

This is responsive to the Final Office Action mailed November 15, 2007. At the time of the Final Office Action, Claims 1-22 were pending. Claims 1-22 stand rejected. Claims 1, 2, 6, 7, 8, 13, 21, and 22 are currently amended. Claims 1-22 remaining pending.

Claim Objections

The claims are currently amended to overcome objections related to use of “services/products” instead of “services or products.” The rejection related to “use to” is moot with the current amendments to claim 2.

Rejections under 35 U.S.C. §103

Claims 1-2, 4-8, 12-13, 15-17, 19, and 21-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,510,411 (hereinafter “*Norton*”) in view of U.S. Patent Application Publication No. 2002/0091529 A1 (hereinafter “*Whitham*”). Independent claims 1, 2, and 21 are currently amended and are patentable over *Norton* in view of *Whitham* for at least the reasons discussed herein.

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere & Co.* set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *See Graham*, 383 U.S. 1 (1966).

i) Determining Scope and Content of Prior Art

In determining the scope and content of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior

art references that are reasonably pertinent to that problem (the inventor's field of endeavor). *See Heidelberg Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994). In selecting references, hindsight must be avoided at all costs.

Norton relates to systems in which computers carry on spoken language dialogs with users. *See Norton*, column 1, lines 5-8. *Norton* is intended to provide a way to simplify the process of developing call or dialogue flows for use in spoken dialog systems. *See Norton*, column 2, lines 21-24. This is intended to prevent a developer from having to anticipate every possible dialog state and to specify content for every dialog state. *See Norton*, column 1, lines 27-31. *Norton's* Figure 3 is a block diagram of a top-level task, specifically, a dinner meal order which is performed. *See Norton*, column 7, lines 57-61. *Norton* discusses "a concept," which is a value that is chosen for a roleset and becomes the filler of the roleset. *See Norton*, column 5, lines 43-44. A roleset has a range and a set of concepts that are its possible fillers. *See Norton*, column 5, lines 53-55.

Whitham relates to a multimedia book that provides hands-on multimedia instruction to the user in response to voice commands. *See Whitham*, ABSTRACT. *Whitham* discloses that the user of a cookbook is typically not able to read the book on topics of technique while attempting to cook, for example. *See Whitham*, paragraph [0004]. According to *Whitham*, a traditional book is simply too valuable to the user to be ruined while using it. *See Whitham*, paragraph [0005]. To facilitate interactive operation of *Whitham's* disclosed books, a voice recognition system is disclosed with limited vocabulary of commands including READ, CONTENTS, VIDEO, PLAY, RETURN, and BACK ARROW. *See Whitham*, page 2, paragraph [0013].

ii) Differences Between the Prior Art and the Claims at Issue

The second step within the test described in *Graham* is ascertaining the differences between the cited prior art and the claims at issue. A prima facie showing of obviousness requires the Examiner to establish that the prior art references teach or suggest, either alone or in

combination, all of the limitations of the claimed invention. The showings must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

There are fundamental differences between the cited references and the rejected claims; furthermore, no combination of the references teaches or suggests all the limitations of the rejected claims as amended.

Regarding claim 1, there are many differences in the disclosed prior art and the rejected claims. The prior art, taken alone or in combination, simply does not disclose every element of amended claim 1. Further, the Office Action is inconsistent in applying the elements of *Norton* to the claimed subject matter to establish an alleged prima facie case for obviousness. What is more, the relationship of components (as cited from *Norton* and depended on by the Office Action) do not comport with the antecedent basis requirements of rejected claim 1 as amended.

The Office Action cites *Norton*'s Figure 3A and col. 7, ll. 64-66 as allegedly disclosing rejected claim 1's recitation of "grouping services or products in the categories," which is currently amended to recite "grouping services or products other than the HTU call system in the categories." The cited portion (i.e., FIG. 3A) of *Norton* does not disclose these elements of rejected claim 1 as originally drafted nor as amended. As *Norton* describes, Figure 3A's order 310 (i.e., "the complete order 310" according to column 7, line 63) is a top level task with rolesets such as sandwich 311, side 312, and drink 313. *See Norton* column 7, line 62-65. The Office Action apparently relies on *Norton*'s rolesets (e.g., sandwiches, sides, and drinks) as "services or products" that are grouped. Rejected claim 1's next element recites "associating one or more HTU topics with each service or product." For this element of rejected claim 1, the Office Action simply recites, "(associating sandwich, drink and side with order service)." For this element, the one or more HTU topics is apparently "order service." The next element of rejected claim 1 recites, "storing at least one HTU dialog module for each HTU topic, such that the dialog module can be played as a voice message of HTU instructions to the caller, wherein HTU instructions ~~include instructions about how to use~~ are operating instructions for the service or product associated with the HTU topic corresponding to the HTU dialog module."

The cited portions of *Norton* do not disclose that at least one HTU dialog module is stored for each “order service.” Nor does the cited portion of *Norton* disclose that any stored dialog module can be played as a voice message of HTU instructions to the caller. Nor does the cited portion of *Norton* disclose that any HTU instructions are operating instructions for rolesets (i.e., “services or products” as relied upon by the Office Action), such as sandwiches, sides, and drinks (as this relied upon by the Office Action). Generally, the cited portions of *Norton* disclose providing the caller with a chance to ask for help in using *Norton*’s disclosed system. *See e.g., Norton*, col. 13, lines 1-16. The Office Action is inconsistent in applying the elements of *Norton* to the claimed subject matter and fails to establish a prima facie case for obviousness.

Rejected claim 1 recites “wherein some topics have two or more dialog modules to be played as a set, different topics having different numbers of dialog modules.” As allegedly reciting this element, the Office Action cites *Norton*’s description of *Norton*’s fillers possibly having additional structure. *See Norton*, column 8, line 4-5 (as cited by Office Action on p. 4 last paragraph). As an example of fillers having additional structure, *Norton* discloses that although a tuna salad concept 321 may be specified as a filler for sandwich 311, the type of bread 314 may remain to be specified. In other words, as *Norton* describes, tuna salad becomes a subtask to be performed. Further, as *Norton* describes, the roleset of tuna salad/bread may consist of white, rye, whole wheat and Kaiser roll. *See Norton*, column 8, lines 5-10. Simply put, the cited portions of *Norton* do not disclose the elements of rejected claim 1. The cited portions of *Norton* describe concepts (e.g., concept 321) and rolesets (e.g., tuna salad). The rolesets may have additional substructure. *See Norton*, column 8, lines 8-11. This description of rolesets with additional substructure does not describe, however, that some “topics have two or more dialog modules to be played as a set, different topics having different numbers of dialog modules.” The Office Action states “sandwich topic is followed by prompt for asking for side order and available choices of side order played as a set,” but this does not sufficiently point out the recited elements that are allegedly disclosed in *Norton*, taken alone or in combination with the other references. Further, citing *Norton*’s sandwich as allegedly disclosing a claimed “topic” is inconsistent with previous assertions of the Office Action and does not follow with antecedent

basis requirements of rejected claim 1. As allegedly reciting previous elements of claim 1, *Norton's* disclosure of “sandwich, side and drink” was relied upon as disclosing claim 1’s “grouping services or products into categories.” Therefore *Norton's* sandwich was apparently viewed as a claimed “service or product.” Then, as allegedly reciting claim 1’s “associating one or more HTU topics with each service or product”, the Office Action relies on *Norton's* “sandwich, drink, and side” as a “topic.” For claim 1’s element related to “storing at least one HTU dialog module for each HTU topic...” the Office Action reverses course and relies on *Norton's* “specific tasks” (e.g., STATUS, CORRECTION, HELP, REPEAT, START OVER) as claimed “topics.” See Office Action ¶ 3, p. 4 citing *Norton's* column 13, lines 1-16). The Office Action inconsistently cites *Norton* and does not establish a prima facie case of obviousness.

Rejected claim 1 further recites “during a call from a caller, prompting the caller to name or describe a service or product or to ask for a list of ~~services/products~~ services or products, and receiving a response from the caller.” The Office Action relies upon *Norton's* column 5, lines 15-32 as allegedly disclosing these elements. The cited portion of *Norton* does not disclose prompting any caller to name or describe a service or product or to ask for a list of services or products. The Office Action does not establish a prima facie case that this element is disclosed by *Norton* alone or in combination with the other references.

Rejected claim 1 further recites “in response to the prompting step, recognizing the caller’s response such that unsupported ~~services/products~~ services or products are recognized and an appropriate message is played.” As allegedly reciting this element, the Office Action cites *Norton's* column 24, lines 54-56. This portion of *Norton* does not disclose recognizing a caller's response as an unsupported service or product. Instead this cited portion of *Norton* is simply a disclosure of sound file names and some example content including “Sorry, I didn't understand that” and “Sorry, I didn't understand what you said about [sic]” This portion of *Norton* is not a disclosure of the claimed elements. The Office Action further cites to *Norton's* column 27, lines 13-23, which describes that *Norton's* Dialog Manager may recognize an input value as appropriate to the task domain but inappropriate for some reason to the current task situation. See *Norton*, column 27, lines 13-18. For example, if a user attempts to order a small

drink before a drink has been ordered, *Norton's* disclosed system may provide the user with the following comment, "Sorry, I didn't understand what you said about small." See *Norton*, column 27, lines 20-23. No unsupported service or product, as recited by the rejected claim, is disclosed. Therefore, *Norton*, alone or in combination with the other references, does not disclose recognizing a caller response for an unsupported service or product in response to a prompting step.

For rejected claim 1's element, "wherein some topics have two or more dialog modules to be played as a set, different topics having different numbers of dialog modules," the Office Action cites *Norton's* "topic of sandwich." However, earlier, the Office Action cites *Norton's* "sandwich" as disclosing rejected claim 1's "services or products" that are associated with one or more HTU topics (which was allegedly disclosed by *Norton's* "order service."). Rejected claim 1 recites elements that have antecedent basis to other elements within claim 1. However, the Office Action is inconsistent in its use of *Norton's* elements that allegedly disclose rejected claim 1's elements. The Office Action does not establish a prima facie case that *Norton*, alone or in combination with the other cited references, discloses every limitation of rejected claim 1. For at least these reasons, claim 1 is allowable over the cited references alone or in combination.

Claim 1 further recites, "playing to the caller the HTU instructions in the at least one HTU dialog module stored for the selected topic, such that if the selected topic has two or more associated dialog modules to be played as a set, the caller may request to have the HTU instructions in any selected HTU dialog module in the set repeated." As allegedly reciting these elements, the Office Action cites to *Norton's* disclosure from column 19, line 64 to column 20, line 15. The cited portion of *Norton* discusses a greeting compartment at the start of a new session. This gives the user a chance to ask for directions before proceeding to the top-level task. For example, *Norton's* disclosed system says an initial prompt "if you would like instructions on the use of the system" may be played for the caller. *Norton's* disclosed system also allows a user to be informed that the user may ask for CHOICES for answering a question, STATUS of a session, and provides the user with the ability to make a CORRECTION. This does not disclose playing HTU instructions, wherein the HTU instructions **are operating**

instructions for the service or product associated with the HTU topic, and wherein the services or products grouped into categories as required by claim 1 are **other than the HTU call system**. Therefore *Norton*, taken alone or in combination with the other cited references, simply does not disclose every element of rejected claim 1 as amended.

For at least the reasons discussed, *Norton* and the cited references, taken alone or in combination, do not render the subject matter of amended claim 1 obvious. Therefore, claim 1 is allowable over the cited references.

Regarding claim 2, the Office Action relies on most of the same portions of *Norton* as were relied on regarding claim 1's rejections. Therefore, the above arguments regarding claim 1 are incorporated by reference and applied to claim 2 for relevant portions. As discussed above regarding claim 1, *Norton* whether taken alone or in combination with the other references, does not disclose every limitation of claim 2.

Additionally, amended claim 2 recites "wherein HTU instructions **are operating instructions for** ~~include instructions about how use to~~ the corresponding services or products." No combination of the references discloses these elements. The Office Action cites *Norton* at column 13, lines 1-16. The cited portion of the *Norton* says that a caller may ask for CHOICES, STATUS, CORRECTION, HELP, REPEAT, START OVER, and STOP. The cited portion, taken alone or in combination with the other references, does not disclose any HTU instructions that are operating instructions for services or products (e.g., sandwiches as disclosed by *Norton* and relied upon by the Office Action). Therefore, for at least this reason, claim 2 is patentable over the cited references. For at least these reasons, claim 2 and its dependent claims are patentable over the cited references, taken alone or in combination.

Amended claim 13 recites "a Get Service Name module configured to prompt the caller to name or describe a service or product **other than the HTU call system** or to ask for a list of services or products **other than the HTU call system**, and for recognizing the caller's response; ~~wherein the services or products are not inclusive of the automated self-service HTU call system~~." As allegedly disclosing these elements, the Office Action relies on *Norton's* column 8,

lines 55 which prompts the user with the question "What type of sandwich do you want?" A description in *Norton* of asking a caller what type of sandwich he or she wants is not sufficient disclosure for anticipating or rendering obvious a Get Service Name module as claimed. The cited portion of *Norton*, taken alone or in combination with the other references, is not a module that prompts the caller and recognizes the caller's response.

Further, claim 13 recites, "Information modules for providing the caller with verbal HTU instructions associated with the selected topic, the HTU instructions including instructions for using the selected service or product." As allegedly disclosing these elements, the Office Action relies on *Norton's* , lines 5-6 which disclose "slaw, or potato salad.' Properties of role-set order: drink:". This portion of *Norton* does not disclose an Information module as claimed. The Office Action also cites *Norton* at column 13, lines 1-16 as allegedly disclosing providing a caller with verbal HTU instructions associated with the selected topic wherein the HTU instructions include instructions for using the selective service or product. The cited portion of *Norton*, rather than disclosing the claimed elements, states that a user is told he or she may ask for CHOICES, STATUS, CORRECTION, HELP, REPEAT, START OVER, or STOP. This disclosure by *Norton* does not disclose a module for providing a caller with verbal HTU instructions associated with any selected topic as claimed. Further, this portion of *Norton*, taken alone or in combination with the other cited references, does not disclose any HTU instructions that include instructions for using the selective service or product. In summary, taken alone or in combination with the cited references, *Norton* does not disclose every element of amended claim 13.

Claims 3-12 and 14-22 depend directly or indirectly from claims 2 and 13. For at least the reasons discussed above, the cited references, taken alone or in combination, do not recite the limitations of the claims or render the claims obvious. Further, there is no motivation to combine the references to result in the rejected claims as amended.

iii) Motivation to Combine

In order to establish a prima facie case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge that one having ordinary skill in the art would have been led to modify or combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281 (Fed. Cir. 1985). The motivation or suggestion to modify or combine references must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q. 2d 1453, 1458 (Fed. Cir. 1998). The showings must be clear and particular. *In re Dembiczka*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence. *Id.* In order to establish a prima facie case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). Simply relying upon the Examiner's own subjective opinion is insufficient to establish a prima facie case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

The Office Action does not, as required, state sufficient motivation to combine the references. As motivation to combine *Norton* and *Whitham*, the Office Action states "it would have been obvious to modify *Norton* to enhance its how to use capability with 'how to use' for actual products and services...in order to provide 'do-it-yourself (DIY) repair and maintenance books, such as home repair and automobile repair and maintenance books'... and to provide an interactive book giving hands-on instruction to the user in response to voice commands." The stated motivation is not sufficient to motivate one of ordinary skill in the art to take the teachings of *Norton* and modify them with the teachings of *Whitham* to result in a method of providing a verbal dialog interface for a caller to an automated self-service "how to use" (HTU) call system

as disclosed in claims 1, 2, and 13. In addition to there being no motivation to combine *Norton* and *Whitham*, the resultant combination of the two references, even as stated by the Office Action, does not result in claimed subject matter of amended claims 1, 2 and 13. Indeed, an interactive book as disclosed in *Whitham* combined with a task oriented dialog model and manager (in which a sandwich is a task, for example) as disclosed in *Norton* does not result in a method of providing a verbal dialog interface for a caller to an automated self-service “how to use” (HTU) call system. Further, such an interactive book as achieved by combining *Norton* and *Whitham* is distinguishable from a system for providing a verbal dialog interface for a caller to an automated self-service “how to use” (HTU) call system as recited in claim 13.

Claims 3, 10, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. *Norton* and *Whitham* and further in view of U.S. Patent Application Publication No. 2002/0055351 A1 (hereinafter “*Elsey*”). No combination of the references recites every limitation of these rejected claims for at least the reasons discussed above regarding claims 2 and 13. Further, the Office Action's stated motivation is insufficient. Therefore, claims 3, 10, and 20 are patentable over the cited references, taken alone or in combination.

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. *Norton* and *Whitham* and further in view of U.S. Patent Application Publication No. 2001/0014146 A1 (hereinafter “*Beyda*”). No combination of the references recites every limitation of these rejected claims for at least the reasons discussed above regarding claims 2 and 13. Further, the Office Action's stated motivation is insufficient. Therefore, claims 9 and 18 are patentable over the cited references, taken alone or in combination.

Claims 11 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. *Norton* and *Whitham* and further in view of U.S. Patent Application Publication No. 2001/0025309 A1 (hereinafter “*Macleod Beck*”). No combination of the references recites every limitation of these rejected claims for at least the reasons discussed above regarding claims 2 and 13. Further, the Office Action's stated motivation is insufficient. Therefore, claims 11 and 14 are patentable over the cited references, taken alone or in combination.

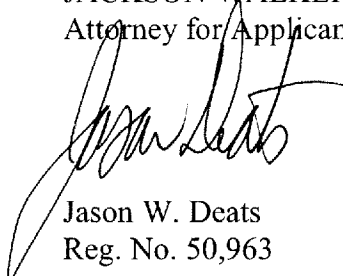
CONCLUSION

Applicants believe this response addresses each ground of objection and rejection in the response. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge fees in the amount of \$810.00 for a Request for Continued Examination and \$460.00 for a two-month extension of time, as well as any further fees necessary, or credit any overpayment, to Deposit Account No. 10-0096 of Jackson Walker L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-236-2025.

Respectfully submitted,
JACKSON WALKER L.L.P.
Attorney for Applicants



Jason W. Deats
Reg. No. 50,963

SEND CORRESPONDENCE TO:
JACKSON WALKER L.L.P.
CUSTOMER ACCOUNT NO. **67942**
512.236.2025
512.391.2162 (FAX)